

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 98-108, 110, 111, 138-155.

The following claims are *independent*: 98, 112, 127, 138, 148-151.

The following claims have previously been *withdrawn*: 112-137.

The following claims have previously been *cancelled* without prejudice or disclaimer: 1-97, 109.

Please *add new* claims 152-155; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 98, 100-102, 104, 107, 108, 148 and 150-151 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, et al., US Patent No. 5,835,896 (hereinafter “Fisher”), in view of Barzilai, et al., US Patent No. 6,012,045 (hereinafter “Barzilai”), and in further view of Bigus, et al., US Patent No. 6,401,080 (hereinafter “Bigus”). The Office Action rejected claims 138-141, and 143-145 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, and in further view of Huberman, US Patent No. 5,826,244 (hereinafter “Huberman”). The Office Action rejected claims 103 and 105 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, and in further view of Godin, US Patent No. 5,890,138 (hereinafter “Godin”). The Office Action rejected claims 106 and 111 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, and in further view of Cathay Pacific Airways auctions article (hereinafter “Cathay”). The Office Action rejected claim 149 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, in further view of Godin, and in further view of Cathay. The Office Action rejected claims 99 and 110 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, and in further view of Spallone, U.S. Patent No. 4,959,686 (hereinafter “Spallone”). The Office Action rejected claim 142 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, in further view of Huberman, and in further view of Godin. The Office Action rejected claims 146 and 147 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Fisher, in view of Bigus, in further view of Huberman, and in further view of Cathay.

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," (§ 2106 II(C), emphasis added) and, "All words in a claim must be considered in judging the patentability of that claim against the prior art." (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to

¹ The "[Graham] factors continue to define the inquiry." 550 U.S. 398 (2007).

consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and/or **(B)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do not discuss, do not render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in previously presented independent claim 98:

A system, comprising:

...

take an action to deter the customer from submitting multiple conditional purchase offers for said goods or services, wherein said action includes restricting submission of additional conditional purchase offers containing a progressively increasing unit price following an initial conditional purchase offer rejection.

The Office Action asserts the above claimed elements are shown in Bigus. The Examiner admits:

Fisher does not disclose take an action to deter the customer from submitting multiple conditional purchase offers for said goods or services, wherein said action includes restricting submission of additional conditional purchase offers containing a progressively increasing unit price following an initial conditional purchase offer rejection.

However, the Examiner attempts to remedy this deficiency in Fisher by relying on Bigus and alleging:

Bigus discloses [it] ... (col. 9, lines 43-49 and col. 8, lines 31-35, *disclosing a negotiation process which will terminate if an offer from a bidder is unacceptable, i.e. taking an action to prevent more offers for goods and services from a customer, furthermore, a counteroffer module is in place that will prevent further offers until the counter offer is made*); (Office Action, p. 4, § 5; emphasis original).

Applicant disagrees and submits the Office Action mischaracterized Bigus.

In direct contrast to the Office Action's assertions, Applicant submits that Bigus discusses a *negotiation agent that encourages submission of offers with progressively increasing prices*. In Bigus, determining whether to complete a transaction depends on "P_{accept}, which is a number between 0 and 1 that represents the probability that agent **100** will accept the other party's last offer irrespective of the fact that its last offer was not fully agreed to," (Bigus, col. 14, lines 38-41). Bigus discusses, "for a selling agent, block **164** is instead executed to calculate P_{accept} as a product of P_{cycles} and another probability function, P_{bid}," (Bigus, col. 15, lines 1-3). Bigus explains, "consequently, the probability that the transaction will be completed increases over time, as well as depending upon how close the current asked and bid prices are," (Bigus, col. 15, lines 13-15; emphasis added).

Furthermore, in Bigus, determining whether to counteroffer depends on "P_{counter}, which is a number between 0 and 1 that represents the probability that agent **100** will continue negotiations by making a counteroffer," (Bigus, col. 15, lines 45-47). Bigus discusses, "for a selling agent, block **172** is instead executed to calculate P_{counter} as a product of P_{cycles} and another probability function, P_{bid}," (Bigus, col. 15, lines 6-8). Bigus explains, "P_{bid} may be a

function which increases from 0 to 1 based upon B_n, the current bid price received from the other party," (Bigus, col. 15, lines 9-11; emphasis added).

Accordingly, Applicant submits that Bigus's *negotiation agent that increases the probability that an offer will be accepted for offers with progressively increasing prices* is different from at least the claimed:

take an action to deter the customer from submitting multiple conditional purchase offers for said goods or services, wherein said action includes restricting submission of additional conditional purchase offers containing a progressively increasing unit price following an initial conditional purchase offer rejection,

as recited in independent claim 98.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Applicant also submits that neither Fisher, which describes an electronic system for conducting a multi-person interactive auction, nor Barzilai, which describes an auction system that encourages submission of multiple bids from bidders, nor Huberman, which describes brokering of bids for document services, nor Godin, which describes a rapid feedback reverse auction process, nor Cathay, which provides general description of online airline ticket sales, nor Spallone, which describes an automated shopping order entry system, remedy the deficiencies identified above in Bigus with regard to independent claim 98. For at least the reasons discussed above, Applicant submits that the pending rejection has

mischaracterized the language of the claim element(s) and/or the applied reference(s) and, thus, has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

Although of different scope than independent claim 98, Applicant submits claims 138, 148-151 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Bigus with regard to independent claim 98. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)'

objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 98-108, 110, 111, 138-155, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17200-020CT2. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17200-020CT2.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
Attorney(s) for Applicant,
CHADBOURNE & PARKE LLP

Dated: February 10, 2011

By: /Walter G. Hanchuk/
Walter G. Hanchuk
Registration No.: 35,179

Correspondence Address:

CHADBOURNE & PARKE LLP
30 Rockefeller Plaza
New York, NY 10112

212-408-5100 (Telephone)
212-541-5369 (Facsimile)
patents@chadbourne.com (E-mail)